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IN THE UNITED STATES DESIGNATED OFFICE
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER THE PATENT COOPERATION TREATY-CHAPTER II

RESPONSE TO RESTRICTION REQUIREMENT

5 APPLICANT: Armin Labatzke
 SERIAL NO.: 09/673,105 GROUP ART UNIT: 2832
 FILED: October 10, 2000 EXAMINER: M. Nguyen
 TITLE: "SUPPORT FOR ELECTRONIC COMPONENTS"

Assistant Commissioner for Patents,

10 Washington, D.C.

S I R:

 In the Office Action dated April 4, 2001, claims 1-12 and 16 (all
pending claims in the application) were the subject of a restriction
requirement under 35 U.S.C. §121 and §372. The Examiner stated claims
15 1-12 are drawn to a structure of a carrier member composed of a ceramic for
electronic components, and claim 16 is drawn to a method for manufacturing
an electronic component. The Examiner stated these two inventions do not
relate to a single general inventive concept under PCT Rule 13.1 because,
under PCT Rule 13.2, the Examiner stated they lacked the same or
20 corresponding special technical features. As substantiation for this
conclusion, the Examiner stated "Armin" shows, in Figure 2, all of the subject
matter of claim 1. The Examiner stated the ceramic is 15, the contact
surfaces are 17b and 17d, with further metallized surfaces 15a and 15b.

 This restriction requirement is respectfully traversed for the following
reasons.

 Claim 16 herein is a rewritten version of original PCT claim 15. The
rewriting of claim 15 was done solely because the editorial changes in that
claim which would have been necessary to bring the claim into conformity

with the requirements of 35 U.S.C. §112, second paragraph, would have been relatively extensive, and it was easier and less confusing simply to cancel claim 15 and rewrite it as claim 16, with the appropriate editorial revisions included therein. Claim 16 was not intended to have any different substantive content as compared to claim 15, and Applicant does not believe that it does.

The original PCT claims corresponding to claims 1-12 herein were examined initially by the International Searching Authority together with claim 15, and the International Searching Authority made an implicit decision that unity of invention does, in fact exist, since no restriction requirement was made by the International Searching Authority. Under the provisions of MPEP §1850, Applicant respectfully submits the Examiner is required to give deference to this implicit decision made by the International Searching Authority, and the Examiner is not permitted to reach a different conclusion, as long as the claims under examination in the United States Patent and Trademark Office (as they do) differ only in editorial respects from the claims examined by the International Searching Authority. In MPEP §1850, in the third paragraph below the heading "The Requirement for 'Unity of Invention'" it is stated that when the United States Patent and Trademark Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office Under 35 U.S.C. §371, PCT Rules 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. §111.

Applicant submits that claims 1-12 and claim 16 fall into the category of 37 C.F.R. §1.475(b)(1) as a product and a process specially adapted for the manufacture of this product. As explained in MPEP §1850, the decision

in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that it was an unreasonable interpretation to say that the expression "specifically designed" (which was in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other.

Applicant respectfully submits that under the above criteria, the Examiner has not demonstrated a persuasive reason to depart from the implicit decision made by the International Searching Authority that unity of invention does, in fact, exist.

The Examiner's analysis regarding the "Armin" reference appears to be misplaced. First, "Armin" is the first name of the present Applicant. Given the reference numerals used by the Examiner, it appears that the Examiner intended to refer to the Azuma reference, which was one of the references that was also cited by and considered by the International Searching Authority. The Azuma reference, therefore, does not provide any "new" information to the present Examiner which was not already available to the International Searching Authority.

More importantly, however, the Examiner relied on the Azuma reference apparently for the purpose of demonstrating that independent claim 1 (in the opinion of the Examiner) did not avoid the prior art. This is not a relevant consideration, however, for determining unity of invention between a product claim and a process claim, but is only relevant with regard to determining unity of invention between an independent claim and claims depending therefrom, as set forth in Section A of MPEP §1850.

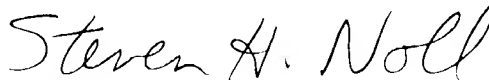
Also, Applicant respectfully submits the Examiner is incorrect in comparing the elements disclosed in the Azuma reference to the elements of independent claim 1. The Examiner appears to consider the two non-planar conductive regions 17a and 17b as being comparable to the non-

planar conductive regions claimed in claim 1, however, in the Azuma reference these non-planar conductive regions 17a and 17b are connected only by a resistive path 18a, rather than by a conductive connection as required in claim 1 (and as required in claim 16 as well).

5 Therefore, Applicant respectfully submits the Examiner's restriction requirement is legally in error as well as factually in error, and withdrawal of that restriction requirement is therefore respectfully requested.

 Subject to the above traversal, as required by 37 C.F.R. §1.143 Applicant herewith makes a provisional election of claims 1-12 for immediate
10 examination in the event that the restriction requirement is maintained.

Submitted by,



(Reg. 28,982)

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AMENDMENT "A" PRIOR TO ACTION

APPLICANT: Armin Labatzke
ATTORNEY DOCKET NO. P00,1774
INTERNATIONAL APPLICATION NO: PCT/DE99/01007
INTERNATIONAL FILING DATE: April 1, 1999
10 INVENTION: "SUPPORT FOR ELECTRONIC COMPONENTS"
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant herewith amends the above-referenced PCT application as
15 follows, and request entry of the Amendment prior to examination in the
United States National Examination Phase.

IN THE SPECIFICATION:

On page 1, above line 1, insert a centered heading

--TITLE--

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above line 2, insert:

--BACKGROUND OF THE INVENTION

Field of the Invention--;

in line 2, insert --present-- preceding "invention";

above line 4, insert a left margin-justified heading:

25

--Description of the Prior Art--;

in line 5, cancel "plastics" and substitute --plastic-- therefor;

in line 6, cancel "derive" and substitute --are obtained-- therefor;

in line 19, cancel "great" and substitute --large-- therefor;

in line 22, cancel "a lessening of the planarity occurs in", and after
30 "pins" insert --becomes somewhat non-planar--.